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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,134	05/08/2001	Izumi Harada	070639/0135	1256

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FOLEY AND LARDNER
SUITE 500
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WASHINGTON, DC 20007

EXAMINER


ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/850,134		HARADA, IZUMI 	
	Examiner		Art Unit	
	Pierre E. Elisca		3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to Applicant's Response, filed on 9/1/2004.
2. Claims 1-45 are pending.
3. The rejection to claims 1-45 under 35 U.S.C. 103 (a) as being unpatentable over Kawan and Moskowitz as set forth in the Office action mailed on 6/15/2004 is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-45 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kawan (U.S. Pat. No. 6,442,532) in view of Moskowitz et al. (U.S. Pat. No. 5,822,432).

As per claims 1, 2, 7-20, and 23-45, Kawan substantially discloses a wireless financial information, and settlement, comprising:

preparing deal information in said deal of said goods or said service in which a seller sells and said purchaser purchases (see., abstract, col 3, lines 10-67);

Art Unit: 3621

reading in said deal information by said mobile terminal (see., abstract, col 2, lines 11-23);

a settlement computer by said mobile terminal (see., abstract, col 3, lines 25-29, col 5, lines 24-33). It is obvious to realize that most cellular phone have an e-mail address see., fig 2C. **It is to be noted that Kawan fails to explicitly disclose the process of authenticating the seller and the purchaser based on the purchaser identification and the seller identification.** However, Moskowitz discloses a seller identification and a purchaser identification (see., abstract, col 9, lines 5-15, col 13, lines 15-20). Moskowitz further discloses a digital watermark or fingerprint see., abstract, col 3, lines 15-40). **Storing purchaser identification information for identifying a purchaser by a mobile terminal". It is believed that Moskowitz discloses this limitation in col 9, lines 5-15, col 13, lines 15-20. Please note that the watermark of Moskowitz also includes or stores seller identification and purchaser identification.** Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the wireless transaction of Kawan by including the limitations detailed above as taught by Moskowitz because this would provide a secure wireless or mobile terminal financial transactions.

As per claim 3, Kawan discloses the claimed method of wherein at said step of displaying said deal information by said mobile terminal (see., fig 2C, col 4, lines 7-17). It is to be noted that Kawan fails to disclose the seller identification. However, Moskowitz discloses a seller identification and a purchaser identification (see., abstract,

Art Unit: 3621

col 9, lines 5-15, col 13, lines 15-20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the wireless transaction of Kawan by including the limitations detailed above as taught by Moskowitz because this would provide a secure wireless or mobile terminal financial transactions.

As per claims 4, 5, 6, 21, and 22 Kawan discloses a wireless financial information, and settlement, comprising:

preparing deal information in said deal of said goods or said service in which a seller sells and said purchaser purchases (see., abstract, col 3, lines 10-67);

reading in said deal information by said mobile terminal (see., abstract, col 2, lines 11-23);

a settlement computer by said mobile terminal (see., abstract, col 3, lines 25-29, col 5, lines 24-33);

displaying said deal information (see., fig 2 C, col 4, lines 7-17). It is to be noted that Kawan fails to explicitly disclose the process of authenticating the seller and the purchaser based on the purchaser identification and the seller identification. However, Moskowitz discloses a seller identification and a purchaser identification (see., abstract, col 9, lines 5-15, col 13, lines 15-20). Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the wireless transaction of Kawan by including the limitations detailed above as taught by Moskowitz because this would provide a secure wireless or mobile terminal financial transactions.

RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 9/1/2004 have been fully considered but they are moot in view of new ground (s) of rejection.

REMARKS

7. In response to Applicant's arguments, Applicant argues that the prior art of record (Kawan and Moskowitz) fail to disclose:

a. **" Kawan's reference directed to portable terminals for providing financial information and performing financial transactions. Whereas, Applicant's claimed invention is directed to performing a sale of a good or service or settling a transaction". However, the Examiner respectfully disagrees since Kawan discloses this assertion in col 3, lines 13-30, specifically wherein said data for settlement of various customer transactions. Please note that customer transactions also include sale of a good.**

b. **" there is no motivation to combine digital watermarking technology of Moskowitz et al to the portable ATM technology of Kawan". The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the**

art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilli & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App & Inter); and *Es parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to *Ex parte Levengood*, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, *In re Keller*, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. *In re Soli*, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

c. "storing purchaser identification information for identifying a purchaser by a mobile terminal". Based upon foregoing rejection detailed above, it is believed that Moskowitz discloses this limitation in col 9, lines 5-15, col 13, lines 15-20. Please note that the watermark of Moskowitz also includes or stores seller identification and purchaser identification which is readable as purchaser ID information for identifying a purchaser and a seller ID information for identifying a seller.

d. **"the process of authenticating the seller and the purchaser based on the purchaser identification and the seller identification"**. However, Moskowitz discloses a seller identification and a purchaser identification (see., abstract, col 9, lines 5-15, col 13, lines 15-20). Moskowitz further discloses a digital watermark or fingerprint see., abstract, col 3, lines 15-40). **Storing purchaser identification information for identifying a purchaser by a mobile terminal"**. It is believed that Moskowitz discloses this limitation in col 9, lines 5-15, col 13, lines 15-20. Please note that the watermark of Moskowitz also includes or stores seller identification and purchaser identification. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the wireless transaction of Kawan by including the limitations detailed above as taught by Moskowitz because this would provide a secure wireless or mobile terminal financial transactions.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3621



Pierre Eddy Elisca

Primary Patent Examiner

November 08, 2004